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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,116	12/09/2003	Kazuhiko Isogawa	0754-0196P	4333
2292	7590	11/21/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,116

Applicant(s)

ISOGAWA ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 1,3,4,6,10 and 13 rejected under 35 U.S.C. 102(b,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwami '667.

Iwami golf balls coated with polyesterpolyol + polyisocyanate paints. The polyesterpolyol can have MW's and hydroxyl numbers within applicant's range (col 7 line 1-15). Although the paint is not said to be aqueous, the final painted ball is the same regardless what carrier was used. The carrier (solvent or water) has evaporated from the final ball. The paint can have a thickness of 5-20 microns (col 3 line 16). The NCO/OH ratio is 1.2 (col 6 line 2).

Claims 1,3,4,6 and 8-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Patzschke '822 in combination with Iwami '667.

Patzschke exemplifies (#10) an aqueous coating composition of polyesterpolyol and polyisocyanate. The polyesterpolyol had a hydroxyl number of 82 (col 11 line 23) diluted with butyl alcohol (ie ethyleneglycol butylether). The preferred MW's of the polyesterpolyol is 3000-6000 (col 2 line 29). Patzschke discloses applicant's coating material, but does not suggest specific substrates.

Iwami teaches similar polyesterpolyol + polyisocyanate coatings are favorable on golf balls. It would have been obvious to place Patzschke's coating on any substrate – including golf balls. The environmental advantages of Patzschke's reduced solvent coatings (col 1 line 14) would manifest themselves on any substrate.

Applicant's arguments filed 10/12/05 have been fully considered but they are not persuasive.

Applicant argues Iwami '667 is directed to solvent borne rather than aqueous paints.

The examiner is unable to locate where Iwami indicates what carrier his paint uses.

Applicant argues that Iwami's painted golf ball is not formed from an "aqueous" polyol and therefore cannot meet the claims.

The "aqueous" limitation is analogous to a product by process limitation. The final painted ball is the same regardless what carrier was used. The carrier has evaporated in its final cured state. The applicant has not provided any evidence that the cured ball of Iwami is unobviously different from applicant's cured ball. See MPEP 2113 for a discussion of product by process claims.

Applicant argues Iwami and Patzscke cannot be combined because Iwami is directed to solvent borne coatings while Patzschke is directed to aqueous coatings.

This is not convincing. The examiner cannot find where Iwami is limited to solvent borne coatings. In fact, Iwami states there is no restriction on the types of paint (col 3 line 18). It is clear that Patzschke considers his aqueous paint to be an improvement over solvent borne paints (col 1 line 11-15; col 9 line 17-22). This is the motivation to switch from a solvent borne paint (assuming Iwami's is actually solvent borne) to an aqueous paint. Applicant provides no reasoning why such a substitution would not be expected to succeed.

Also note applicant requires solvents in some claims (claim 9; spec page 11 line 22).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER
PRIMARY EXAMINER

11/14/05

David Buttner